

### **Remarks**

After entry of the forgoing amendments, claims 39-49 and 51-64 are pending. Claims 39, 51-58 and 61-64 have been amended herein. Claim 50 has been cancelled. Support for these amendments may be found at least at page 2, lines 28 and 29 (C1, C2 and C3), at least at page 17, lines 15-29 (amino acid residue combinatorial unit), at least at page 6, line 14 to page 14, line 6 (limits on n, m, p and q) and at least at page 22, line 24 to page 24, line 11 (method steps). Applicants submit that no new matter has been added with these amendments.

### ***Information Disclosure Statement***

Applicants have resubmitted the Information Disclosure Statements herewith to supply titles for the publications.

### ***Specification***

Applicants have amended the title to "LIBRARY OF COMPOUNDS COMPRISING PYRROLOBENZODIAZEPINE MOIETIES" which Applicants believe is indicative of the claimed invention. Thus, Applicants respectfully request that the rejection be withdrawn.

### ***Objections to the Claims***

Claim 39 was objected to because contained the word "and" twice in a row at the end of the claim. Claim 39 has been amended to correct this typographical error and Applicants respectfully request that the objection be withdrawn.

### ***Rejections Under Section 112, Second Paragraph***

Claims 39, 51-58 and 61-63 stand rejected as indefinite because it is unclear which carbons are C1, C2 and C3. The claims have been amended to indicate which carbons are C1, C2 and C3. Applicants respectfully submit that the amendments obviate the rejection and request that it be withdrawn.

Claims 39, 40, 51-58 and 61-63 stand rejected as indefinite for the use of the term "up to 12 carbon atoms" when used in conjunction with aryl and aralkyl. Applicants respectfully submit that the term is definite and meets the requirements of 35 U.S.C. 112, second paragraph. According to the MPEP,

[t]he essential inquiry pertaining to [the definiteness] requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

(MPEP 2173.02). One of ordinary skill in the art would not interpret the claims to mean that an aryl group may contain zero carbon atoms. An aryl (or aralkyl) group by its nature has at least 3 carbon atoms. For example, five membered aromatic rings such as imidazole, pyrazole, oxazole, isoxazole and thiazole each contain 3 carbon atoms and 2 heteroatoms (nitrogen, oxygen and sulfur or combinations thereof) and five membered aromatic rings such as furan, pyrrole and thiophene each contain 4 carbon atoms and one heteroatom (oxygen, nitrogen and sulfur respectively).

Claim 63 stands rejected under 35 U.S.C. 112, second paragraph, for the use of the limitation “the formula XV” as there is no antecedent basis for the limitation in the claim. Applicants have amended claim 63 to delete the “the” and therefore request that the rejection be withdrawn.

Claim 64 stands rejected under 35 U.S.C. 112, second paragraph, as being an incomplete method claim. Applicants have amended claim 64 to specifically recite a positive method for the screening. Applicants, therefore, request that the rejection be withdrawn.

#### ***Rejections under Section 112, First Paragraph***

Claims 39-64 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to convey that the Applicants had possession of the invention. Applicants have amended the claims such that T, T', T'' and T''' are now “amino acid residue combinatorial units” and that n, m, p and q are now limited to 1 to 16. Applicants respectfully submit that these amendments sufficiently clarify the scope of the claimed invention such that one of ordinary skill in the art would understand that Applicants had possession of the invention as filed and request that the rejection be withdrawn.

Claim 64 stands rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure that is not enabling because the method steps have not been included in the claim. Applicants have

amended claim 64 to recite method steps. The claim now recites both a contacting and a selection step, which are enabled by the specification. Thus, Applicants respectfully request that the rejection be withdrawn.

### Rejections Under Section 102(b)

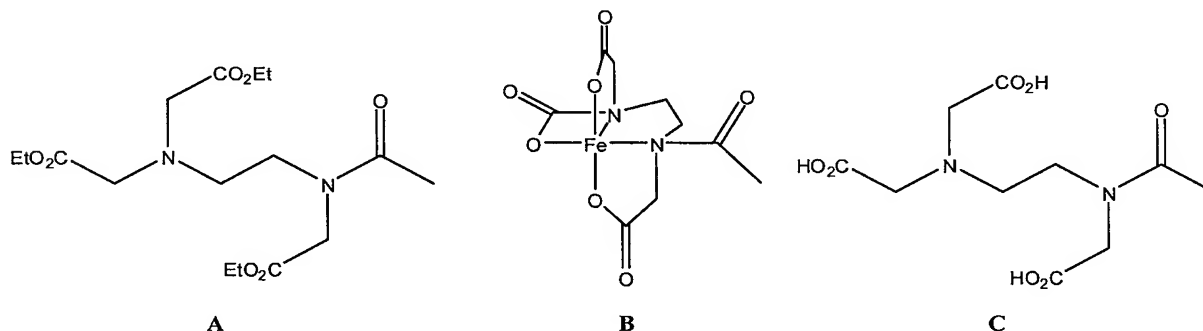
Claims 39-51, 53 and 64 stand rejected under 35 U.S.C. 102(b) as being anticipated by Thurston et al., *Chem. Comm.* **1996**, 4, 563-565. The Office Action cites Thurston et al. as disclosing a collection of pyrrolobenzodiazepines linked to Et<sub>3</sub>EDTA (compound 14), EDTA (compound 14 after the hydrolysis step), or EDTA linked to metals like iron (compound 15).

The Manual of Patent Examining Procedure ("MPEP") § 2131 states that, in order to anticipate a claim, a reference must teach every element of the claim:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California* 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1222, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

MPEP § 2131. As T is now defined as "an amino acid residue combinatorial unit" and a "combinatorial unit" is "any monomer unit which can be used to build a chain" (page 7, lines 16-18), Applicants respectfully submit that Thurston et al. does not teach or suggest the claimed invention.

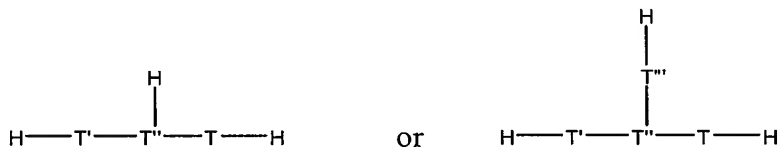
In order for claim 39 to be anticipated by compounds 14 (A) and 15 (B) and the hydrolysis product of compound 14 (C), one of the groups depicted below



must be -(T)<sub>n</sub>-H. Although the hydrolysis product (C) could be a combinatorial unit because it has removable hydrogen atoms, it is not an amino acid residue combinatorial unit. Neither

of the other structures contains a removable hydrogen atom that would allow it to function as a combinatorial unit. Thus, none of the structures depicted above is an amino acid residue combinatorial unit. Applicants respectfully submit that claim 39 is not anticipated by Thurston et al and request that the rejection be withdrawn.

Similarly, for claims 51 and 53 to be anticipated one of the above groups must be



respectively, wherein each of T, T', T'', and T''' are amino acid residue combinatorial units. As is discussed above, not only are **A** and **B** not amino acid residue combinatorial units, they do not contain a removable hydrogen to allow them to function as combinatorial units at all. **C** is not an amino acid residue combinatorial unit, even though it could be a combinatorial unit. Thus, Applicants respectfully submit that Thurston et al. does not teach or suggest the claimed invention and request that the rejection be withdrawn.

As the remaining claims are dependent on one of claims 39, 51 or 53, Applicants respectfully submit that they are not anticipated by Thurston et al. for at least the reasons discussed above and request that the rejection be withdrawn.

### CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance. Should the examiner feel that any issues remain or wish to discuss anything further, the examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Charlene L. Yager". The signature is fluid and cursive, with the first name "Charlene" being more prominent and the last name "Yager" written in a more compact, cursive style.

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